

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 11-18-02 APPL. SN.: 01 900312
EXAMINER: [Signature] ART UNIT: 1762
PARALEGAL: DEBORAH THOMAS MAILROOM DATE: 7-2-02
AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS MEMO TO ME.

- ☒ The T.D. is PROPER and has been recorded. (See 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).
- ☐ The recording fee of \$_____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.25).
- ☐ Application Examiner has not processed T.D. fee. (See fee authorization).
- ☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.1).
- ☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection. Rule 321(c). (See 14.27, 14.27.1).
- ☐ It is directed to a particular claim(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted." MPEP 1490. (See 14.26, 14.26.2).
- ☐ The person who signed the terminal disclaimer:
- ☐ has failed to state his/her capacity to sign for the business entity. (See 14.28).
 - ☐ is not recognized as an officer of the assignee. (See 14.29 and possibly 14.29.1).
- ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).
- ☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72).
- ☐ The T.D. is not signed. (See 14.26, 14.26.3).
- ☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney.
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is mis or incorrect. (See 14.32).
- ☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is mis or incorrect. (See 14.26, 14.26.4 or 14.26.5).
- ☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3).
- ☐ Other: _____

JUL 02 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Harald Hess)
Serial No.: 09/900,312) Group: 1762
Filed: July 6, 2001)
Title: DEVICE AND METHOD FOR)
APPLYING A COATING MEDIUM ONTO)
A MOVING SURFACE) Examiner: E. Fuller

COPY OF PAPERS
ORIGINALLY FILED

TERMINAL DISCLAIMER

Commissioner for Patents
Washington, D.C. 20231

07/09/2002 GGEBREGI 00000123 09900312

01 FC:148

110.00 OP

Sir:

The owner, Voith Paper Sulzer Papiertechnik GMBH, of 100 percent (100%) of the entire right, title, and interest in the above-identified patent application by virtue of an assignment dated March 23, 1999, recorded at Reel 9934, Frame 0316, on April 28, 1999, hereby disclaims the terminal part of any patent granted on the above-identified patent application which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,248,407, entitled "METHOD FOR APPLYING A COATING MEDIUM ONTO A MOVING SURFACE", filed April 28, 1999. U.S. Patent No. 6,248,407 is also assigned to Voith Paper Sulzer Papiertechnik GMBH by virtue of an assignment dated March 23, 1999 and recorded at Reel 9934, Frame 0316, on April 28, 1999. The owner hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title of said patent shall be the same as the legal title to U.S. Patent No. 6,248,407, this agreement to run with any patent granted on the above-identified patent application and to be binding upon the grantee of such patent, its successor or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term, as presently shortened by any Terminal Disclaimer, of U.S. Patent No. 6,248,407 in the event that U.S. Patent No.

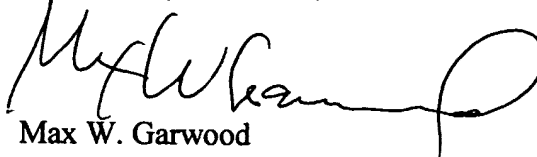
VOI0131.CON

6,248,407 later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321 (a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer.

The undersigned is an attorney of record.

A check in the amount of \$110.00 as provided by 37 C.F.R. 1.20(d) is submitted with this Terminal Disclaimer. If any additional fee is required, please charge to Account No. 20-0095, Taylor & Aust, P.C.

Respectfully submitted,



Max W. Garwood
Registration No. 47,589

Attorney for Applicant

COPY OF PAPERS
ORIGINALLY FILED